

28. The method as claimed in claim 25, wherein said thermoplastic elastomer comprises elastiflicated polyolefin, styrene block copolymer, copolyester elastomer, thermoplastic polyurethane, or a suitable mixture thereof.
29. The method as claimed in claim 25, wherein said castable polyurethane system comprises a two-component or multi-component polyurethane system.
30. In an offset printing machine having a damping system wherein the improvement comprises said dampening system comprises a roller comprising a roller core and a roller covering being composed of an elastomer material containing fluorinated polyolefin or elastic plastic material containing fluorinated polyolefin. - -

### REMARKS

The applicant respectfully requests reconsideration in view of the amendment and following remarks. The applicants have rewritten claim 12 into independent form as newly added claim 19. Support for newly added claims 20-29 can be found in claims 2-11 respectively. Support for newly added claim 30 can be found in the specification at page 1, lines 30-34.

The applicant appreciates that the Examiner has acknowledged the receipt of the priority documents.

Claims 1 through 8, 13, 14 and 16 through 18 were rejected under 35 U.S.C. § 102(b) as anticipated by Eddy *et al.* U.S. Patent No. 6,007,657 (hereinafter referred to as "Eddy"). Claims 1 through 3, 6 through 9, 13, 14, 16 and 17 were rejected under 35 U.S.C. § 102(e) as anticipated by Umemoto *et al.* U.S. Patent No. 6,020,417 (hereinafter referred to as "Umemoto"). Claim 9

was rejected under 35 U.S.C. § 103(a) as being unpatentable over Eddy in view of Takizawa *et al.* U.S. Patent No. 5,903,808 (hereinafter referred to as "Takizawa"). Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Eddy in view of Blaszak *et al.* U.S. Patent No. 5,120,609 (hereinafter referred to as "Blaszak"). Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Eddy in view of Priebe *et al.* U.S. Patent No. 5,869,188 (hereinafter referred to as "Priebe"). Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nishiwaki U.S. Patent No. 3,926,701 (hereinafter referred to as "Nishiwaki") in view of Eddy. Claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Eddy. The applicant respectfully traverses these rejections.

In order to expedite prosecution the applicants have cancelled their previous independent claims and have one independent claim based on claim 12. The applicants also have newly added independent claim 30 drawn to an offset printing device. Claim 12 was only rejected under 35 U.S.C. § 103(a) as being unpatentable over Nishiwaki in view of Eddy.

Nishiwaki teaches cylindrical fabric coverings for damping form rollers, wherein the damping form rollers are rubber rollers, i.e. rollers having a fabric covering (col. 1, lines 20-25, and col. 4, lines 5-7, 35-36, 60, 63 and 64). The yarns are discussed at col. 2, lines 16-34 and 55-66 of Nishiwaki. The mechanical properties of rubber rollers were already known at the time Nishiwaki made his invention. The applicants discuss in the background of the invention section of the application, numerous rollers with different kinds of rubber or elastomeric covers. However, the applicants claim that the covering being composed of an elastomer material containing fluorinated polyolefin or elastic plastic material containing fluorinated polyolefin.

There was no particular motivation for a person of ordinary skill in the art to combine the teaching of Eddy (dealing with heated fuser members in electrostatographic apparatuses) with Nishiwaki.

Furthermore, Nishiwaki teaches a covering fabric that can be readily fitted on a damping form roller and can supply water to the plate cylinder in a smooth and uniform manner (col. 1, lines 24-26). Since Eddy teaches rollers for an electrostatographic process, which is a dry process, there is another reason why there is no motivation for a person of ordinary skill in the art to combine both teachings.

In addition, Nishiwaki teaches a covering fabric for damping form rollers which is adapted for use with damping rollers varying significantly in diameter (col. 2, lines 8-15). This advantage (col. 3, line 33) can not be achieved by a roller covering being composed of an elastomer material containing fluorinated polyolefin or elastic plastic material containing fluorinated polyolefin as is required in the applicants claimed invention (see independent claims. Thus, both Eddy and the present invention teach away from Nishiwaki.

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters without any direction as to the particular one selection of the reference without proper motivation. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious unless desirability of such modification is suggested by the prior art (In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would

selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination, although it may have been obvious to try various combinations of teachings of the prior art references to achieve the applicant's claimed invention, such evidence does not establish prima facie case of obviousness (In re Geiger, 2 USPQ 2d. 1276 (Fed. Cir. 1987)). There would be no reason for one skilled in the art to combine Nishiwaki in view of Eddy. For the above reasons, this rejection should be withdrawn.

Assuming arguendo that a prima facie case of obviousness has been made by the Examiner, the applicants believed that the showing in the specification at page 7, lines 10-26 rebuts this rejection. The applicants have performed a comparative example with the only difference being a rubber cover compared to a rubber cover containing polytetrafluoroethylene (PTFE). The cover containing the fluorine did not need to be cleaned at the end of the shift while the covering not containing the fluorine had to be cleaned three times. This means that the process had to be stopped in order to clean the rollers. This effect causes considerable downtime loss (see page 2, lines 12-17 of the specification). Again, for the above reasons, this rejection should be withdrawn.

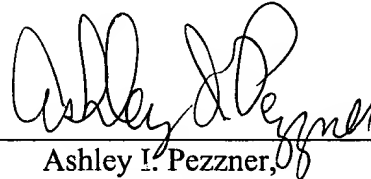
No additional fees are due. If there are any additional fees due in connection with the filing of this response, including any fees required for an additional extension of time under 37 CFR 1.136, such an extension is requested and the Commissioner is authorized to charge or credit any overpayment to Deposit Account No. 03-2775.

For the reasons set forth above, Applicants believe that the claims are patentable over the references cited and applied by the Examiner and a prompt and favorable action is solicited. The applicants believe that these claims are in condition for allowance, however, if the Examiner disagrees, the applicants respectfully request that the Examiner telephone the undersigned at (302) 888-6270.

Respectfully submitted,

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